

ATTORNEY DOCKET NO. 10628ROUS01U (NORT10-00169)
U.S. SERIAL NO. 09/472,910
PATENT

REMARKS

Claims 2-7 and 37-50 are pending in the application.

Claims 2-7 and 37-50 have been rejected.

Reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 103**

Claims 2-7 and 37-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sonesh, et al. (US Patent 6,046,762) in view of Wolff, et al. (US Patent 5,327,486). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

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of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Independent Claims 2 and 37 recite "call reception logic" that operates to "query capabilities of the particular remote telephone station prior to sending the data information message," where a "format for the data information message" is "determined based upon the capabilities of the particular remote telephone station." Independent Claim 45 similarly recites "querying capabilities of the particular remote telephone station prior to sending the data information message" where the "format for the data information message being determined based upon the capabilities of the particular remote telephone station.

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The Office Action acknowledges that Sonesh fails to disclose these elements of independent Claims 2, 37 and 45. See, Office Action, page 3. The Office Action asserts that Wolff teaches "identifying the caller by enabling the caller to speak to the personal telephone manager (PTM) and that the information would be translated to text for call screening either by the PTM or transmitting as text to the caller in an auditory form." Office Action, page 3. Based on this, the Office Action concludes that it would be obvious to "incorporate the feature of identifying the capabilities of the caller's telephone station prior to sending the information message to the caller, as taught by Wolff" in Sonesh's system. Office Action, page 3.

The Applicant respectfully submits that the Office Action mischaracterizes the teachings of Wolff. Wolff recites a system and method for managing telephone calls using a personal telephone manager (PTM) 12. Wolff, Abstract. A portable computer 18 used by a called party may transmit a text message to the PTM 12, which converts the text message into audio for delivery to a calling party. Wolff, Abstract; Col. 5, lines 1-6. The called party could also select a pre-recorded voice message to be presented to the calling party. Wolff, Col. 5, lines 57-61. In addition, the PTM 12 could use speech-to-text conversion or voice recognition to allow the calling party to identify himself or herself, and the text is then transmitted to the called party's portable computer 18. Wolff, Col. 7, Lines 5-14.

Wolff does not disclose or teach querying a telephone station device to determine the device's capabilities. Wolff merely converts text from a called party into speech for a calling party and where speech from the calling party is converted into text for the called party, and the calling

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party, himself or herself, may be identified from the speech of the calling party. Wolff, Col, 7, lines 5-14. This identification process does not refer or relate to querying the telephone station to identify capabilities of the telephone station - the capabilities determining the format of the data information message.

In contrast, Applicant's claims recite that call reception logic (or step) operates to query capabilities of the particular remote telephone station prior to sending a data information message to the remote telephone station, whereby the format of the data information message is determined based upon the capabilities of the remote telephone station. See, Claims 2, 37 and 45. Wolff does not teach or disclose querying the remote telephone station for determining the capabilities of the remote telephone station to further determine a format required in order to transmit a data information message (in that format) to the remote telephone station. This feature of Applicant's claimed invention is described in Applicant's Specification, page 21, lines 9-23.

For these reasons, the Office Action does not establish that the proposed Sonesh-Wolff combination discloses, teaches, or suggests all elements of independent Claims 2, 37 and 45.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 2-7 and 37-50.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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